

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/074,484

Applicant(s)

ANDERSEN ET AL.

Examiner

SON P. HUYNH

Art Unit

2424

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 4, 6-12, 14, 16, 17, 20 and 22-25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

June 23, 2009

/Son P Huynh/
Primary Examiner, Art Unit 2424

Continuation of 11. does NOT place the application in condition for allowance because: Response to Arguments

Applicant's arguments filed 6/9/2009 have been fully considered but they are not persuasive.

Applicant argues the claim requires associating a second predefined unique symbol with a second type of supplementary content. This is not done in the cited reference. The PIP symbol has nothing to do with supplementary content and only has to do with the original content and whether content is displayed in two images. Further, it is required that the predefined unique symbol is provided in association with a listing and a program schedule. This also does not happen (page 7, paragraph 2). This argument is respectfully traversed.

It is noted that the Examiner need not give patentable weight to non functional descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004) and BPAI recent final decision in *Ex parte Curry*, 2005-0509 (BPAI 2005), 84 USPQ2d 1272 (Affirmed, Rule 36, Fed. Cir., slip op. 06-1003, June 2006). In this case, the limitation "'first predefined unique symbol" or "second predefined unique symbol" are drawn to descriptive material not functionality related to the method. Thus, the Examiner does not need to give patentable weight to nonfunctional descriptive material, as it "will not distinguish the invention from the prior art in terms of patentability." In *Re Nga*, at 1339. Regardless of whether the combination of the references teach "first predefined unique symbol" or "second predefined unique symbol", the limitation will not differentiate the claimed invention from the prior art.

Nonetheless, the Examiner has found that the teaching of associating a symbol for television and chat, etc. with second type of supplemental content such as television content and/or chat content of Stautner meets the claimed "associating a second predefined unique symbol with a second type of supplementary content" (see figures 2-3, col. 5, lines 25-30, col. 7, lines 35-50 and final office action, pages 7-8, bridge paragraph). Stautner also discloses unique symbols (see figures 2-5) are provided in association with listings on a program guide screen with program schedule reads on the predefined unique symbol is provided in association with a listing and a program schedule.

Applicant also argues Farwell has nothing to do with two-screen interactivity mode on the display. The two screen static web mode is described in the present specification as involving two screens, a television screen and a computer display that are used to present the content in conjunction with the program. This does not happen in the cited reference.... he does not have anything that indicates that the supplementary content needs two different devices to display it (page 7, paragraph 3). This argument is respectfully traversed.

According to M.P.E. P 2106 II, C, "limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In this case, neither limitation "the two-screen static web mode involving two screen, a television screen and a computer display that are used to present the content in conjunction with the program" nor "the supplemental content needs two different devices to display it..." is recited in the claims.

In the final office action, the examiner relies on Stautner's disclosure of interactivity display screen with multiple screens for displaying chat content, interactive program guide content, television content, and other supplementary content (see figures 2-5, col. 5, lines 25-30, col. 7, lines 35-50 and discussion in Final office action, pages 7-8) meets the claimed "two screen interactivity mode" In response to applicant's arguments against the references individually (i.e., Farwell has nothing to do with two-screen interactivity mode on the display), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Examiner relies on Stautner for the teaching of associating predefined symbol with a type of supplementary content, and two-screen interactivity mode; program schedule that includes a listing for a television program. The examiner relies on Farwell for the teaching of a symbol to indicate two-screen mode. Therefore, the combination of Stautner with the teaching of symbol indicate two-screen mode taught by Farwell, meets all features as recited in claim 1.

With respect to rejection of claim 14, Applicant argues the cited reference to Farwell has nothing to do with a second listing for a television program that has supplementary content (page 7). This argument is respectfully traversed.

As discussed in the Final Office action, pages 6-8, 11-12, the Examiner relies on Stautner for the teaching of a second predefined unique symbol associated with a second listing; the second listing is a listing for a television program that has supplementary content.

For the reasons given above, rejections on the claims 1, 4, 6-12, 14, 16-17, 20, 22-25 are sustained as indicated in the Final Office Action..